

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	§	Filed: May 3, 2001
Bates et al.	§	
	§	Group Art Unit: 3621
Serial No.: 09/848,573	§	
	§	Examiner: Pierre E. Elisca
Confirmation No.: 6829	§	

For: Systems and Methods for Operating Vending Machines

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to fax number 571-273-8300 to the attention of Examiner Pierre E. Elisca, or electronically transmitted via EFS-Web, on the date shown below:

November 17, 2008
Date

/Mayra Bravo/
Mayra Bravo

Dear Sir:

REPLY BRIEF

Applicants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to Examiner's Answer mailed on September 16, 2008. While Applicants' maintain each of the arguments submitted in Applicants' previously submitted Appeal Brief, Applicants make the following further arguments in light of the Examiner's Answer.

Status of Claims

Claims 1-7, 10, 13-15, 17 and 18 are pending in the application. Claims 1-48 were originally presented in the application. Claims 49 and 50 have been added during prosecution. Claims 8, 9, 11, 12, 16, and 19-50 have been canceled without prejudice. Claims 1-7, 10, 13-15, 17 and 18 stand finally rejected as discussed below. The final rejections of claims 1-7, 10, 13-15, 17 and 18 are appealed. The pending claims are shown in the attached Claims Appendix.

Grounds of Rejection to be Reviewed on Appeal

1. Rejection of claims 1-7, 10, 13-15, 17 and 18 are under 35 U.S.C. 102(e) as being anticipated by *Newell et al.* (U.S. Patent No. 5,159, 560, hereinafter, "*Newell*").

ARGUMENTS

1. THE EXAMINER ERRED IN REJECTING CLAIMS 1-7, 10, 13-15, 17 AND 18 UNDER 35 U.S.C. 102(e) AS BEING ANTICIPATED BY *NEWELL*.

Applicants' Reply to the Examiner's Response to Arguments

At issue in this case is whether *Newell* teaches “receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine.” This language can be found in Applicants' independent claims 1 and 17.

The Examiner maintains that because *Newell* discloses allowing an article acquired from one vending machine to be returned to another in the system, it is “inherent” that the system of *Newell* is also capable of checking availability of one other vending machine. Regardless of whether the system of *Newell* is capable of checking availability of one other vending machine, Applicants maintain that allowing an article to be returned to another in the system does not disclose, “receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine” The Examiner has not met the burden to establish inherency, because the Examiner has not made it clear that the missing descriptive matter is necessarily present in *Newell*, and that it would be so recognized by persons of ordinary skill.

Had *Newell* disclosed, for example, (i) a vending machine that allowed the user to specify, in advance, which other vending machine to return a videocassette to; and (ii) the vending machine approving the user's request *only if* the specified other vending machine did not carry a *duplicate* videocassette (i.e., to prevent a vending machine from carrying two copies of *The Godfather*, for example), then the Examiner's position may be more readily maintained. This is because the Examiner may then argue that

checking (by a vending machine) for duplicates in another vending machine necessarily entails checking (by a vending machine) availability of another vending machine.

However, such is not the case in *Newell*. In *Newell*, unlike in the above example, a user does not specify in advance which vending machine to return a videocassette to. Instead, *Newell* merely teaches a plurality of vending machines, all of which are configured to (i) blindly accept any videocassette, regardless of which vending machine the videocassette was from, and then (ii) update inventory files based on the blindly accepted videocassette. See, e.g., *Newell*, col. 4, lines 57-59; col. 5, lines 2-5; col. 14, lines 11-18. Even assuming, *arguendo*, that the system in *Newell* may track inventory based on the information contained in the inventory files, it does not necessarily follow that a particular vending machine in *Newell* is capable of checking availability of another vending machine. Therefore, allowing an article acquired from one vending machine to be returned to another in the system does not teach “receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine.” Accordingly, Applicants respectfully request that the Board vacate the rejection by the Examiner of claims 1 and 17 and their dependents.

CONCLUSION

The Examiner errs in finding that claims 1-7, 10, 13-15, 17 and 18 are being anticipated by *Newell*.

Withdrawal of the rejection and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
Patterson & Sheridan, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Appellant(s)